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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,421	09/27/2001	Syed F.A. Hossainy	50623.60	6381

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EXAMINER

NGUYEN, VI X

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,421

Applicant(s)

HOSSAINY, SYED F.A.

Examiner

Victor X. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 10-13, 29-32, 45-48, 50-53, 56-61, 65-67, 71 and 72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 10-13, 29-32, 45-48, 50-53, 56-61, 65-67, 71 and 72 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 54, 55, 62-64 and 68-70 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The request filed on 11/18/2005 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/966,421 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 112

2. In response to applicant's amendment of 11/18/2005, the examiner has removed all prior 35 USC § 112 rejections.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3,5,45,47-48,50,64-66 and 70-72 are rejected under 35 U.S.C. 102 (e) as being anticipated by Dang et al. (U.S. 6,758,859).

Dang et al show in figures 3-4, a stent (10) that releases drug into the vascular system having depots (30) on a surface of the stent body, including: a first material (see col.5, lines 5-22) carrying a therapeutic substance. A second material (col.4, lines 17-40) configured to convert a first type of energy to a second type of energy. Note that cols. 5, lines 10-14 and lines 54-66 can be interpreted broadly that radioactive isotope for stent usage can be converted from its energy conversion material which is disposed in depots (30) of the stent. At best seen in fig. 4, the stent comprises a top coat deposited over at least a portion of the first material, and where

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the second material is selected from the group consisting of Au (see col. 4, lines 26-29).

Furthermore, the procedures in figures 4 and 6a disclose the second material can fill completely some of the depots and where the top coat includes a polymer.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6,11-13,31-32,51,56-61 and 67 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Dang (6,758,859).

Dang discloses the invention substantially as claimed. However, Dang is silent regarding the second material comprises Au particles having a silica nano particle core or the first material is a temperature sensitive hydrogel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the second material comprises Au particles having a silica nano particle core or the first material is a temperature sensitive hydrogel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use or as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 29-30 and 52-53 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Dang'859. Dang is silent regarding the diameter of Au particles having a silica

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nanoparticle from 100 to 250 nm or having a thickness of 1 to 100 nm. Nevertheless, Dang does disclose Au particles, which must be changed in the size of a component involve merely routine skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make Dang' the diameter of Au particles having a silica nanoparticle from 100 to 250 nm or having a thickness of 1 to 100 nm. Regarding claims 10 and 46, it would have been further obvious to one having ordinary skill in the art at the time the invention was made to have electromagnetic waves with wave lengths between 800 and 1200 nm into thermal energy, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Allowable Subject Matter

5. Claims 7-8, 54-55, 62-64 and 68-70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

None of the prior art of record disclose or suggest where a third material configured to convert a third type of energy received by the third material from an energy source to a fourth type of energy, where the fourth type of energy promotes release of the therapeutic substance from the stent body, and where the first type of energy and the third type of energy are electromagnetic energy, where the electromagnetic energy of the first energy type has a different wavelength than the third energy type.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

6. Applicant's arguments filed 11/18/2005 with respect to claims 1 and 45 have been fully considered but are moot in view of the new ground(s) of rejection. Applicant is asked to please refer to the modified prior art rejection above where examiner addresses applicant's concerns regarding prior art rejections.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,273,908 to Ndong-Lay U.S. Pat. No. 6,764,507 to Shanley

U.S. Pat. No. 6,783,543 to Jang

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen
Examiner
Art Unit 3731

Vn VP
12/21/2005



JULIAN W. WOO
PRIMARY EXAMINER